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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Stephen C P Joseph

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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

NOTIFICATION DATE

DELIVERY MODE

04/15/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/533,743	Applicant(s) JOSEPH, STEPHEN C P	
	Examiner MADELINE GONZALEZ	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

In response to applicant's amendment dated January 16, 2008 and upon further consideration, the previous rejection has been withdrawn

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (U.S. 2,175,714).

With respect to **claim 1**, Brown discloses a filtering receptacle, as shown in Fig. 1, having:

- a reservoir 1;
- a filter 13 including an elongate tubular body closed at one end and open at the other end;
- the open end being provided with a support collar 9 that fits in a filler opening 4 of the reservoir 1 and locates said open end so that the filter body extends away from the opening 4 within the reservoir 1 when liquid is added to the reservoir 1 through the filler opening 4;

- wherein the tubular body of the filter 13 has a surface area and volume when within the reservoir 1 to permit, in use, filling of the reservoir 1 with liquid that is filtered on being added to the reservoir 1 to produce a supply of filtered liquid within the reservoir 1;
- and the filter 13 is flexible (see col. 2, line 5).

The recitation “sufficiently flexible to allow the filter to collapse if the reservoir containing it collapses” is considered a functional recitation which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the filter 13 disclosed by Brown is capable of collapsing if the reservoir 1 collapses, because the filter 13 is a filter bag made of fabric, and therefore it is flexible (see col. 2, line 5).

With respect to **claim 2**, Brown discloses wherein the tubular body of the filter 13 has a cross-section such that the filter 13 can be dropped into the reservoir 1 to locate the support collar 9 in the filler opening 4, as shown in Fig. 1.

With respect to **claim 3**, Brown discloses wherein the tubular body of the filter 13 has an axial length substantially the same as the depth of the reservoir 1 in which it is received, as shown in Fig. 1.

With respect to **claim 4**, Brown discloses wherein the support collar 9 has an external lip 11 at the outer end that seats around the marginal edge of the filler opening 4 to locate and retain the collar 9 in the opening 4, as shown in Fig. 1.

With respect to **claim 9**, Brown discloses wherein the tubular body is provided with at least one annular support hoop 15 spaced from the collar 9, as shown in Fig. 1.

Claims 11-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Gerhenson et al. (U.S. 5,755,962) [hereinafter Gerhenson].

With respect to **claim 11**, Gerhenson discloses a filter assembly, as shown in Fig. 6, having:

- a container 20 having a filler opening, and a filter 3;
- the filter 3 including an elongate tubular body closed at one end and open at the other end, the open end being provided with a collar 24 that fits in the filler opening so that the filter body extends away from the opening within the container 20;
- wherein the container 20 includes an open-topped container and a lid 26 arranged to close the open end of the container 20 and forming the end wall in which the filler opening is formed, the container 20 being collapsible as liquid is withdrawn from the container and the filter 3 is sufficiently flexible to allow the filter to collapse as the container collapses, as shown in Fig. 6.

With respect to **claim 12**, Gerhenson discloses wherein the container has a flexible sidewall and a comparatively rigid base and the sidewall can be foldable to move the base towards the lid as liquid is withdrawn from the container, since the container can be another filter 3 having a semi-rigid shape, as shown in Fig. 8 (see col. 3, lines 8-10).

With respect to **claim 13**, Gerhenson discloses wherein the lid is provided with an extension sleeve 72 surrounding the container to provide support for the container, as shown in Fig. 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. 2,175,714).

Claim 5 adds the further limitation of wherein the support collar is integral with the tubular body of the filter.

Brown **lacks** the limitation of claim 5.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the support collar disclosed by Brown integral with the tubular body of the filter, as claimed by applicant, in order to facilitate its handling, since the courts have held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering choice. (See *MPEP 2144.04 [R-1] (V) [In re Larson, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965)]*).

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. 2,175,714) in view of Williams et al. (U.S. 5,061,303) [hereinafter Williams].

Claim 6 adds the further limitation of wherein the support collar is connected to a cage that surrounds the tubular body of the filter within the reservoir which cage is sufficiently flexible to allow the filter to collapse if the reservoir containing it collapses.

Brown **lacks** a support collar connected to a cage surrounding the filter.

Williams discloses a filter bag unit 24, as shown in Fig. 2, having a collar 42 connected to a cage 40 surrounding the interior of the filter 24, said cage 40 being collapsible, as shown in Fig. 4. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace the member 17 disclosed by Brown with a cage as taught by Williams in order to easily remove and install a filter bag (see col. 6, lines 45-47).

With respect to **claim 7**, Williams discloses wherein the cage 40 includes a plurality of legs 48 extending from the support collar 42 at the open end of the tubular body to a base member at the closed end of the tubular body, as shown in Fig. 2.

Claims 10, 14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303).

With respect to **claim 10**, Kaltenbach discloses a spray gun siphon cup, as shown in Fig. 1, having:

- a container 20, as shown in Fig. 2, having a collapsible side wall and a base on which it can stand unsupported in an upright position and having a filler opening and a filter 32;
- the filter 32 including an elongate tubular body closed at one end and open at the other end, the open end being provided with a support collar that fits in the filler opening so that the filter body extends away from the opening within the container 20; and
- wherein the tubular body of the filter 32 has a surface area and volume within the container 20.

Kaltenbach **lacks** the filter 32 being sufficiently flexible to allow it to collapse as the container side wall collapses.

Williams discloses a filter bag unit 24, as shown in Fig. 2, said unit 24 being collapsible, as shown in Fig. 4. It would have been obvious to a person having ordinary

skill in the art at the time the invention was made to replace the filter disclosed by Kaltenbach with a collapsible filter as taught by Williams in order to easily remove and install a filter bag (see col. 6, lines 45-47).

With respect to **claim 14**, Kaltenbach discloses wherein the elongate tubular body of the filter 32 is tapered toward the closed end, as shown in Fig. 3.

With respect to **claim 17**, Kaltenbach discloses wherein the opening is not an open end of the reservoir, since the opening is on the cover 28, as shown in Fig. 3. The term “filler opening” has been considered an intended use recitation.

With respect to **claim 18**, Kaltenbach discloses a container 19 and a circular lid 28, and the opening is in the lid 28 and has a diameter of one-half the diameter of the lid or less, as shown in Fig. 3.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaltenbach (U.S. 3,432,104) in view of Williams (U.S. 5,061,303) as applied to claim 10 above, and further in view of Brown (U.S. 2,175,714).

Claim 15 adds the further limitation of wherein the tubular body of the filter is oriented at an angle that is not parallel to the side wall of the reservoir.

Claim 16 adds the further limitation of wherein the reservoir is characterized by a shape having a longitudinal axis and the filler opening is offset from the reservoir longitudinal axis.

Kaltenbach as modified by Williams **lacks** the limitations of claims 15 and 16.

Brown discloses a filtering receptacle, as shown in Fig. 1, having a filter 13 oriented at an angle not parallel to a side wall of a receptacle 1, and an opening 4 offset from the receptacle 1 longitudinal axis. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to relocate the filter and opening disclosed by Kaltenbach to an angle not parallel to the side wall of the reservoir, and offset from the longitudinal axis of the reservoir, respectively, as taught by Brown since the courts have held that shifting the position of a particular element is unpatentable as long as the operation of the device is not modified (see *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950)).

Response to Arguments

Applicant's arguments with respect to claims 1-7 and 9-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David R. Sample/
Supervisory Patent Examiner,
Art Unit 1797

Madeline Gonzalez
Patent Examiner
April 8, 2008